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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,569	10/26/2001	Esha A. Gangolli	21402-191 (CURA 491)	8659

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EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

412

Office Action Summary

Application No.

10/055,569

Applicant(s)

GANGOLLI, ESHA A.

Examiner

Michael Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10,12-14,19,30,33,39 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10,12-14,30,33 and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/29/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary amendment filed August 6, 2002 and August 18, 2002 have been entered.
2. Applicant's election with traverse of Group B in the reply filed on September 27, 2004 is acknowledged. The traversal is on the ground(s) that Group E and Q are drawn to methods which are not distinct. This is not found persuasive because the groups are classified separately. Applicants further argue that it would not be a search burden to examiner groups E and Q in addition to the elected group. However, the search of the methods require specific method steps search and methods are classified separately.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. The information disclosure statement filed as form PTO-1449 on March 29, 2002 has been considered. However, the references drawn to sequences of Genbank or other sequence information where there is not a corresponding scientific journal information has only been considered to the extent possible by the examiner because the sequence comparison is not possible with the provided information.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 5-10, 12-14, 30, 33 and 42-48 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a substantial asserted utility or a well established utility.

The claims are directed to a nucleic acid encoding a polypeptide which is an orphan proteoglycan. The specification on page 4 disclose the asserted utility of using the glypican related protein for analysis of development and cell signaling. However, there is no nexus between the claimed nucleic acid encoding the protein and the therapeutics for humans. The specification as filed does not disclose or provide evidence that points to a property of the claimed protein such that another non-asserted utility would be well established.. The polypeptide lacks substantial utility because further research to identify or reasonably confirm a "real world" context of use is required. Thus, the asserted utility lacks substantial and specific utility because further research to identify or reasonably confirm a "real world" context of use is required. *Brenner V. Manson* 383 U.S. 519, 535-536, 148 USPQ 689, 696 (1966) stated that "Congress intended that no patents be granted on an chemical compound whose sole "utility" consists of its potential role as an object of use-testing ... a patent is not a hunting license." *Brenner* further states that "It is not a reward for the search, but compensation for its successful conclusion." Any utility of the nucleic acid encoding the protein or other specific asserted utility is directly dependent on the function of the protein. A circular assertion of utility is created where the utility of the protein is needed

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to break out the circular assertion of utility. The polypeptides do not substantial utility because the skilled artisan would need to prepare, isolate, and analyze the protein in order to determine its functional nexus with human therapeutics. Therefore, the invention is not in readily available form. Instead, further experimentation of the protein itself would be required before it could be used. The disclosed use for the nucleic acid molecule of the claimed invention is generally applicable to any nucleic acid and therefore is not particular to the nucleic acid sequence claimed. The disclosed use directed to vectors and host cells do not have utility because the nucleic acid without utility is needed to practice the inventions.

Claims 5-10, 12-14, 30, 33 and 42-48 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recite "hybridizes under stringent conditions" which is confusing and ambiguous because the stringent condition is a relative term for which the metes and bounds are not clear. It is not clear what are the boundaries between a stringent condition and non-stringent conditions.

6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Claims 10 encompass an isolated nucleic acid encoding polypeptide variants and fragments of proteins without functional limitations. However, the essential feature of the invention is the polypeptide channel subunit of SEQ ID NO:20, and one of skilled in the art cannot envision the full genus of molecules of the claimed polypeptide molecules. The claims encompass variants whose structure is not known or other variant proteins with different function from SEQ ID NO:20 taught in the specification. Claimed protein variants encompass a large genus of proteins or channels which are alleles or variants whose function has yet to be identified from different species of animal because the structure of the newly identified naturally occurring protein is not

known. *University of California v. Eli Lilly and Co. (CAFC) 43 USPQ2d 1398* held that a generic claim to human or mammalian when only the rat protein sequence was disclosed did not have written description in the specification.

7. Claims 42-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification does not disclose the claim limitations of claims 42-48. The specification on pages 58-69 does not disclose the claimed changes.

Priority

8. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the applications upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 5-10, 12-14, 30, 33 and 42-48 of this application for the reasons provided above. See MPEP 706.02.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Stripp et al. (J. Cell Biol., 1994).

Stripp et al. discloses a nucleic acid encoding a protein which is 83% best local similarity to the claimed polypeptide of SEQ ID NO:20 (pages 152-153). Meadows et al. discloses a composition comprising the polypeptide with a carrier (page 17). Meadows et al. discloses hybridization with the nucleic (pages 153-157). Claims 30, 32-35, 74,

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89, 91-94 and 116 are rejected under 35 U.S.C. 102(e) as being anticipated by Meadows et al. (US 6,242,217).

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak whose telephone number is 571-272-0879. The examiner can normally be reached on 8:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 571-272-0829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0507.



Michael Pak
Primary Examiner
Art Unit 1646
2 March 2005